

Atty Docket: ONYX1027-DIV1
Serial No. 09/687,230

REMARKS

The above Amendments and these Remarks are in reply to the Office action mailed May 6, 2003. Applicant will address the Examiner's Remarks in the order presented in the Office action.

Claim Objections

The Examiner has objected to the term "SH2" in Claim 8. Applicant has amended Claim 8 to recite the entire phrase for which the abbreviation is used.

The Examiner's objection to Claim 9 has also been noted and corrections made to amend Claim 9 in accordance to the Examiner's suggestion.

Claim Rejections 35 U.S.C. §112, Second Paragraph

Claims 8-11 and 23 are rejected under §112, Second Paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Regarding claims 8-12, the Examiner has stated that the language of the claims suggest that the C-terminus of several proteins may bind to the intermediate SH2 domain. Applicant has clarified what is intended in terms of the binding properties of the phosphatidylinositol-3' kinase associated protein, as suggested by the Examiner.

As for claim 23, the Examiner will note that Applicant has amended the claim to recite "polynucleotide" as the hybridizing agent, and the stringent conditions under which hybridization is performed.

With the amendments to the claims described above, Applicant respectfully believes that the §112, Second Paragraph rejection is obviated.

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35 U.S.C. § 112 Claim Rejections, First Paragraph

Claim 23 is further rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The Examiner has indicated, in Examiner's section 10, that the specification fails to describe the structural elements required of polynucleotides that hybridize under any conditions to the polynucleotide of SEQ ID NO: 1. Also, in Examiner's section 11, the Examiner has stated that claim 23 is not enabled for essentially the same reason.

The Examiner will note that Applicant has amended claim 23 to recite certain structural characteristics of phosphatidylinositol-3' kinase associated proteins that identify those polynucleotides that hybridize to the polynucleotide of SEQ ID NO: 1. That is, claim 23 recites that such polynucleotides encode a phosphatidylinositol-3' kinase associated protein that have an amino acid sequence comprising the C-terminal amino acids of SEQ. ID No. 2 that bind to the intermediate src homology 2 (SH2) domain on the regulatory subunit of phosphatidylinositol-3' kinase. Applicant believes that this amendment should obviate the rejection, and respectfully request that it be withdrawn.

Double Patenting Objection-37CFR 1.75

The Examiner has objected to claims 9 and 10 as being a substantial duplicate of claim 8. Applicant has cancelled claim 10, which should obviate the objection.

A clean version of pending claims including amendments presented in this response is being provided as **Appendix A**.

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In view of the above Amendments and Remarks, reconsideration of the pending claims is requested.

If the Examiner believes that an interview would expedite the prosecution of Applicants' patent application, the Examiner is encouraged to call the undersigned.

Extension of Time Pursuant to 37 C.F.R. § 1.136(a)

A Petition for Three Month extension of time is being filed concurrently with this response. Applicant respectfully requests a 3 -month extension of time to file a Response to the Final Office Action mailed May 6, 2003. The extended period expires on November 6, 2003

The Commissioner is authorized to charge any fees associated with this communication to Deposit Account No. 15-0615 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: November 6, 2003

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Pending Claims

APPENDIX A

(Clean Version of Pending Claims after Instant Amendment)

Claims 1 – 7 (Canceled)

Claim 8 (currently amended): An isolated phosphatidylinositol-3' kinase associated protein comprising the polypeptide of SEQ ID No. 2 wherein the C-terminal amino acids of said phosphatidylinositol-3' kinase associated protein bind to the intermediate src homology 2 (SH2) domain on the regulatory subunit of phosphatidylinositol-3' kinase.

Claim 9 (currently amended): An isolated phosphatidylinositol-3' kinase associated protein of claim 8 wherein amino acids 151-313 of SEQ ID No. 2 encode a bromodomain.

Claim 10 (cancelled)

Claim 11 (previously amended): A chimeric protein comprising said phosphatidylinositol-3' kinase associated protein(s) of claim 10 fused to a heterologous polypeptide.

Claims 12 – 22 (canceled)

Claim 23 (currently amended): An isolated phosphatidylinositol-3' kinase

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associated protein comprising an amino acid sequence, said amino acid sequence comprising the C-terminal amino acids of SEQ. ID No. 2 that bind to the intermediate src homology 2 (SH2) domain on the regulatory subunit of phosphatidylinositol-3' kinase, which amino acid sequence is encoded by a polynucleotide which hybridizes under stringent conditions to the polynucleotide set forth in SEQ ID No. 1, wherein said stringent conditions comprise hybridization to filter-bound polynucleotide in 0.5M NaHPO₄, 7% sodium dodecyl sulfate, 1mM EDTA at 65 degrees centigrade, and washing in 0.1X SSC/0.1%SDS at 68 degrees centigrade.